

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed October 2, 2002 (the "Office Action"). At the time of the Office Action, Claims 1-38 were pending in this patent application. The Examiner rejected all claims. Applicants make no amendments to the claims. Applicants respectfully request reconsideration and favorable action in this case.

Claim Rejections – 35 U.S.C. §103

The Examiner rejects Claims 1-6, 8-26, 28-34, and 36-38 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,729,693 to Holda-Fleck ("Holda-Fleck") in view of U.S. Patent No. 6,223,168 to McGurl, et al. ("McGurl"). Applicants' Claim 1 recites:

A computer-based interface for facilitating rebate processing, the interface operable to:

receive authorization of a rebate request;

display rebate information retrieved from a remote rebate processing center, the rebate information comprising at least two disbursement options, a first one of the disbursement options having a first cash value to a recipient and a second one of the disbursement options having a second cash value to a recipient, the first cash value different than the second cash value; and

receive a selection of the disbursement options.

Applicants respectfully submit that *Holda-Fleck* and *McGurl*, taken alone or in combination, fail to teach or suggest all elements of Appellants' claims. For example, Claim 1 includes:

... rebate information comprising at least two disbursement options, a first one of the disbursement options having a first cash value to a recipient and a second one of the disbursement options having a second cash value to a recipient, the first cash value different than the second cash value

None of the cited references teach or suggest these aspects of Claim 1. The Examiner admits, on page 2 of the Office Action, that *Holda-Fleck* fails to even contemplate multiple disbursement options. As teaching of these aspects of Claim 1, the Examiner relies on *McGurl*. *McGurl* discloses a system that facilitates remittance of payments via one or more delivery mechanisms. *McGurl*, at col. 1, ll. 11-15. In particular, *McGurl* contemplates disbursement of payments using electronic funds transfer (EFT) or transmittal of negotiable

instruments, based on selections by users. *Id.*, at col. 4, l. 37 - col. 5, l. 18. For example, in describing the system, *McGurl* contemplates users selecting between methods of disbursement, and identifies this as a selection between "whether the disbursement is desired by EFT or printed negotiable instrument." *Id.*, at col. 5, ll. 10-11. However, *McGurl* fails to contemplate the disbursement options of Applicants' Claim 1. Moreover, *McGurl* does not teach or suggest "a first one of the disbursement options having a first cash value to a recipient and a second one of the disbursement options having a second cash value to a recipient, the first cash value different than the second cash value." Thus since neither cited reference teaches or suggests the identified aspects of Claim 1, the rejection under 35 U.S.C. § 103(a) is inappropriate.

In addition, Applicants' submit that the combination of *Holda-Fleck* and *McGurl* is inappropriate for at least three reasons. First, *Holda-Fleck* and *McGurl* are non-analogous art. *McGurl* deals with automatic remittance of payments, while *Holda-Fleck* addresses problems associated with crediting rebates to consumers. The art units of the two references further highlight that *Holda-Fleck* and *McGurl* are non-analogous, as there is no overlap between the U.S. classifications or fields of search for the two references.

Second, *Holda-Fleck* and *McGurl* teach away from a combination. In general *Holda-Fleck* discloses a system for automatically crediting a rebate to a customer over a telephone network. *Holda-Fleck*, Abstract. A primary advantage identified by *Holda-Fleck* is the automatic crediting of the rebate amount to a consumer's telephone bill. *Id.*, at col. 3, ll. 34-41. Thus *Holda-Fleck* identifies a single method for delivering a rebate to a consumer. *McGurl*, as previously discussed, contemplates a user selecting between EFT and paper delivery of payments. Therefore, *Holda-Fleck* and *McGurl* teach away from a combination, since *Holda-Fleck* contemplates a single, automatic method for delivering a rebate while *McGurl* contemplates a user selecting between electronic and paper delivery of a payment.

Third, the combination of the teachings of *McGurl* with *Holda-Fleck* renders *Holda-Fleck* unsatisfactory for its intended purpose. "If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." M.P.E.P., at § 2143.01. *Holda-Fleck* proposes automation and simplification of rebate requests by crediting rebates to customers' telephone bills. *Holda-Fleck*, at col. 3, ll. 2-32. The introduction of disbursement

selections, and in particular the introduction of paper delivery of payments as taught by *McGurl*, simply reintroduces problems that *Holda-Fleck* intends to overcome. At the very least, this modification would change the principle of operation of *Holda-Fleck*, which is similarly unacceptable.

For at least all of these reasons, the combination of these references is inappropriate. Moreover, even if the combination is appropriate, Applicants have shown above that *Holda-Fleck* and *McGurl*, alone or in combination, fail to teach or suggest all elements of Applicants' Claim 1. Applicants' Claims 11, 21, and 31 each include limitations that, for reasons similar to those discussed with respect to Claim 1, are not taught or suggested by the cited references. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection to Claims 1, 11, 21, and 31 and their respective dependent Claims.

The Examiner rejects Claim 7, 17, 27, and 35 under 35 U.S.C. § 103(a) as being unpatentable over of *Holda-Fleck* in view of *McGurl* and further in view of U.S. Patent No. 6,052,675 issued to Checchio ("Checchio"). The Examiner introduces *Checchio* for the concept of using a credit card to cover costs that exceed a purchase credit. However, *Checchio* fails to introduce any of the elements of Applicants' independent claims that are not shown by *Holda-Fleck* or *McGurl*. Moreover, this combination of references is similarly inappropriate as with the combination discussed above. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection to Claims 7, 17, 27, and 35, which depend from independent claims shown above to be allowable.

Conclusions

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

The Commissioner is hereby authorized to charge any other fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicants



Kurt M. Pankratz
Reg. No. 46,977

Address correspondence to:

2001 Ross Avenue
Dallas, Texas 75201-2980
Tel. 214.953.6584; Fax. 214.661.4584
kurt.pankratz@bakerbotts.com

Date: December 3, 2002

ATTORNEY DOCKET NO.
067251.0104

PATENT
Serial No. 09/470,580

13

Marked-Up Version of Specification and Claim Amendments

Applicants make no amendments.